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In re Application of
Guido Galley et al
Serial No.: 10/767,784
Filed: January 29, 2004
Attorney Docket No.: 21453

: PETITION DECISION

This is in response to the petition under 37 CFR 1.144, filed October 26, 2006, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 and contained 24 claims, as filed. The examiner mailed to applicants on May 5, 2006, a restriction requirement, summarized as follows:

Groups I-VII – claim 1, drawn to compounds of Formula IA wherein variable C is one of 7 moieties;

Groups VIII-XIV – claim 1, drawn to compounds of Formula IB wherein variable C is one of 7 moieties;

Groups XV-XXI – claim 22, drawn to processes for preparing compounds of Formula IA wherein variable C is one of 7 moieties;

Groups XXII-XXVIII – claim 23, drawn to processes for preparing compounds of Formula IB wherein variable C is one of 7 moieties;

Groups XXIX-XXXV - claims 20-21, drawn to methods of using compounds of Formula IA wherein variable C is one of 7 moieties;

Groups XXXVI-XLII - claims 20-21, drawn to methods of using compounds of Formula IB wherein variable C is one of 7 moieties.

C is defined as one of phenyl, pyridinyl, furanyl or tetrahydrofuranyl, benzo[b]thiophenyl, tetrahydronaphthyl, indanyl, or 2,2-dimethyl-[1,3]dioxolanyl. (It is presumed that claims 2-19 are grouped with claim 1 for restriction purposes.)

The examiner set forth proper reasons for restriction between the Groups with respect to product, method of making and method of use, and advised of possible rejoinder. No specific reason for

division within the independent claims was set forth, however an election of species was required for whichever Group was elected.

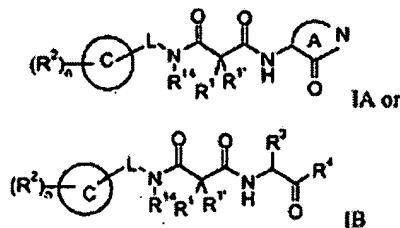
Applicants replied on June 5, 2006, electing with traverse Group I and a species with traverse. Applicants stated that they understood that if the elected species was patentable then the guidelines of M.P.E.P. 803.02 would be followed and also that rejoinder would occur with respect to the method of making and/or using claims.

The examiner mailed an *ex parte Quayle* Office action to applicants on August 25, 2005, acknowledging the election of Group I and responded to the traversal. The examiner maintained the requirement and made it Final based on the variations of moiety C resulting in different classifications and search and examination of all Groups would impose an undue burden. The examiner indicated the claims of Group I to be allowable and indicated rejoinder of Groups XV and XXIX and invited an amendment to make them commensurate in scope with the allowed product claim.

Applicants filed a reply to the Office action which has not yet been considered by the examiner and this petition on October 26, 2006, seeking withdrawal of the entire restriction requirement.

DISCUSSION

Applicants' claims are directed to compounds having the following structures:



Applicants argue that the restriction requirement should be considered in terms of a linking claim with each Group identified by the examiner as a species of the generic claim and where one species is elected and found allowable, the linking claim must also be examined in its entirety.

A review of claim 1 shows that it is not a linking claim in the true sense of the word. M.P.E.P. sets forth the definition of a linking claim, as follows:

809 [R-5] Linking Claims

There are a number of situations which arise in which an application has claims to two or more properly divisible inventions, so that a requirement to restrict the claims of the application to one would be proper, but presented in the same case are one or more claims (generally called "linking" claims) which, if allowable, would require rejoinder of the otherwise divisible inventions. See MPEP § 821.04 for information pertaining to rejoinder practice. Linking claims and the inventions they link together are usually either all directed to products or all directed to processes (i.e., a product claim linking properly divisible product inventions, or a process claim linking properly divisible process inventions). The most common types of linking claims which, if allowable, act to prevent restriction between inventions that can otherwise be shown to be divisible, are

- (A) genus claims linking species claims; and

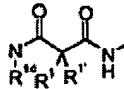
(B) subcombination claims linking plural combinations.

Where an application includes claims to distinct inventions as well as linking claims, restriction can nevertheless be required. The linking claims must be examined with, and thus are considered part of, the invention elected. When all claims directed to the elected invention are allowable, should any linking claim be allowable, the restriction requirement between the linked inventions must be withdrawn.

However, M.P.E.P. 803.02, which deals with Markush practice, is the more appropriate examiner guidance for applicants' claims wherein a Markush group is set forth:

A Markush-type claim recites alternatives in a format such as "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925). The members of the Markush group (A, B, and C in the example above) ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it is clear from their very nature or from the prior art that all of them possess this property. Inventions in metallurgy, refractories, ceramics, pharmacy, pharmacology and biology are most frequently claimed under the Markush formula but purely mechanical features or process steps may also be claimed by using the Markush style of claiming.

Applicants have set forth a Markush group of compounds based on Formulas IA and IB. It is noted that the only common structure in either formula is the substituted malonamide structure shown here:



Everything else is a variable. It is noted that the left side of the structure contains as a variable an -L-C group where L is a bond or short chain alkyl group and C is as defined above. The right side of the structure varies widely and includes many single and fused ring systems optionally with one or more heteroatoms. Each core malonamide structure combined with an -L-C moiety forms a proper separate and distinct Markush group. A proper Markush group is defined as: "Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature essential to that utility." Here each combination of the malonamide core with a different -L-C group forms a separate and distinct substantial structural feature in both Formula IA and IB which is presumed to be essential to the utility disclosed. (The property or activity does not appear to lie solely or primarily with the malonamide core.) Since there are seven separate structures formed a seven way restriction is appropriate. The examiner properly divided the various structures claimed according to the common malonamide core combined with variable -L-C to show the various differing significant structural elements. However, in view of the fact that both Formula IA and IB contain the same seven common cores the requirement for restriction should only have created 21 Groups, not 42.

DECISION

The petition is **GRANTED-IN-PART** in that Groups VIII-XIV are combined with Groups I-VII; Groups XXII-XXVIII are combined with Groups XV-XXI; and Groups XXXVI-XLII are combined with Groups XXIX-XXXV respectively. Applicants' election of Group I applies to

both Formula IA and IB structures. Rejoinder of the appropriate method of making and method of use Groups has been indicated by the examiner.

The application will be forwarded to the examiner for consideration of the amendment filed October 26, 2006, and such action as deemed appropriate.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 703-308-3824 or by facsimile sent to the general Office facsimile number, 571-273-8300.



George C. Elliott
Director, Technology Center 1600